



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/830,142

04/22/2004

Kaveh Towfighi

DT-6799

7829

30377

7590

12/27/2007

DAVID TOREN, ESQ.

ABELMAN FRAYNE & SCHWAB

666 THIRD AVENUE

NEW YORK, NY 10017-5621

EXAMINER

MCDONOUGH, JAMES E

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

12/27/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/830,142	Applicant(s) TOWFIGHI, KAVEH	
	Examiner James E. McDonough	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4-11 and 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-11, and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Original Rejection

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-11 and 13 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rosenbaum (US

2002/0005010) as evidenced by <http://www.sea-doo.net/techarticles/oil/oil.htm>; Feb 02, 2003; Robert Verret.

Regarding claims 1, 2, and 4-7

Rosenbaum teaches a propellant for internal combustion-operated tools, and teaches that they can contain lubricants based on a mineral oil or silicone oil, and references 2-stroke engine oil (para 0020), which, certainly include and read on all the variously claimed lubricants. See Article by Robert Verret included, for a discussion of 2-stroke engine oil composition of API groups III, IV, and V based on hydrocracked/hydrotreated petroleum based oils (a.k.a. this reads on isoparaffin based on poly-olefins), synthetic based oils, and ester synthetic based oils (under section **base oil types**) respectively.

With regard to the boiling point and number of carbons in the branched isomer, these are properties of the composition, and since properties are inseparable from the composition itself, the reference would inherently have these properties, absent any showing to the contrary. Furthermore, Motorcraft sells three grades of 2-stroke oil 5W-20, 5W-30, and 10W-30, which have respective boiling points of 185, 210, and 226 °C, and since it is well known that as the number of carbons increases the boiling point goes up, it would further appear that the oils disclosed by the reference do indeed read directly on those of the instant claims, and if for arguments sake it could be argued that the reference for some reason does not anticipate the claims than they would at least be prima facie obvious to someone of ordinary skill in the art at the time the invention was made to use these lubricants, absent any showing of unexpected results.

Regarding claim 8

Here applicants appear to be trying to define the lubricant based on inherent properties of that lubricant, applicants are reminded that in no way do inherent properties add to the patentability of a compositional claim, furthermore, applicants have not disclosed or provided enablement on where or how this oil can be obtained, if it is argued that this oil is indeed novel over those disclosed by the reference because of some unexpected result.

Regarding claims 9 and 10

Although, Rosenbaum does not disclose how much lubricant should be used, Rosenbaum does disclose that a lubricant can be used, however, because it is only one variable and is considered result effective, because as the lubricant concentration increases the machine would be expected to operate more smoothly and efficiently with less wear and tear, but as the lubricant concentration exceeded a certain amount it would start interfere the combustion reaction while at the same time adding no increased lubricating function, therefore, one skilled in the art would be expected to be able to optimize this parameter without undue experimentation to arrive at the claimed amounts.

Regarding claims 11-13

Rosenbaum teaches these exact amounts of the same exact reagent list (paras 0005 and 0006), it appears that these claims are verbatim with the disclosure of Rosenbaum, therefore, they are anticipated by the reference. Furthermore, looking at the claim set of the reference it can clearly be seen that the elected species are also

disclosed individually, preempting any argument against picking and choosing components from the reference.

New Rejection

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not understood by the examiner how a carbonaceous fuel can burn without producing a residue, as it is well known that all carbonaceous materials when burned will produce a residue, even if it is only condensed water.

Response to Arguments

Applicant's amendment to the claims changing aplane to alkane is persuasive, therefore the objection has been withdrawn.

Applicants argue that even though the reference does teach the use of a lubricating oil it does not disclose the specific lubricating oil. This is not persuasive because:

- 1.) Applicants do not claim a specific oil as there are many thousands of compounds that read on this "oil".
- 2.) What do applicants propose the composition of the mineral or silicone oil is and since the reference is claimed two-stroke engine oil and a supplemental reference was evidenced to show what two-stroke engine oils are and that they read on the instant claims.
- 3.) Applicants have shown no evidence that the oil of the reference is not the same as claimed, but only offer mere allegation that they are not the same.

Applicants argue that the two-stroke oil does not burn without leaving a residue, then argue that the oil has an additive that prevents the formation of residue. This is not persuasive because whether the oil has an additive or not applicants admit that it burns without leaving a residue. Also applicants have not described any specific oil that will burn without leaving a residue and it is highly unlikely that any 9-16 carbon branched alkane will burn completely and not produce a residue. Examiner would also like to note that just because no residue is built up does not mean that no residue is produced, and applicants own specification teaches that residue can build up but that it is easily wiped away with a rag and the help of cleaning solvent (pages 5-6 of the instant specification). Furthermore, the claims use comprising language which does not exclude additional components.

Applicants argue that dust particle that are introduced with the air act as abrasives. Examiner would like to point out to applicants that combustion engines use air-filters to remove these particles as it is well known that they are detrimental to the operation of a engine.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James E. McDonough whose telephone number is (571)272-6398. The examiner can normally be reached on 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571)272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number:
10/830,142
Art Unit: 1793

Page 8

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JEM 12/14/2007



J. A. LORENZO
SUPERVISORY PATENT EXAMINER